

REMARKS

Applicant expresses appreciation to the Examiner for consideration of the subject patent application. This amendment is in response to the Advisory Action mailed on August 5, 2010 and in view of the subject matter in the Final Office Action mailed November 16, 2009. In the Final Office Action Claims 1-9 and 11-21 were rejected. The claims have been amended to present the rejected claims in a better form for consideration on appeal under 37 CFR § 1.116(b)(2).

Claims 1-21 were originally presented. Claim 10 was previously cancelled. Claims 1-9 and 11-21 remain in the application. Claims 3 and 19 have been canceled without prejudice in this response. Claims 1, 2, 4-7, 11, 12, 20 and 21 have been amended.

Claim Rejections – 35 U.S.C. § 101

Claims 1-9, 11-18 and 20-21 stand rejected under § 101 as being directed to non-statutory subject matter. Specifically, independent claims 1 and 21 were rejected as not being sufficiently tied to a particular machine or apparatus or physically transforming underlying subject matter to a different state or thing.

The § 101 rejection was made prior to the Supreme Court's recent decision. Thus, the Examiner relied on *In re Bilski* decision from the Federal Circuit, which has since been overturned by the U.S. Supreme Court's decision.

35 U.S.C. § 101 offers patent protection for “any new and useful process, machine, manufacture, or composition of matter”. In the recent *Bilski* decision by the U.S. Supreme Court, the Court held that the machine-or-transformation test developed by the Federal Circuit *does not* define what is (and is not) a patentable process. Rather, the Court held that the machine-or-transformation offers “a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101. The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible process”. *In re Bilski*, 561 U. S. ____ at Syllabus, page 2 or Kennedy Opinion, page 8 (2010).

It should be noted that independent claims 1 and 21 specifically recite that a transformation does occur. Specifically, a selected location is transformed by erecting a plurality

of flags at the selected location to comprise the healing field. This provides strong evidence that claims 1 and 21 are processes under § 101.

In addition, one thing that all nine justices in the recent Supreme Court *Bilski* decision agreed upon is that Bilski's method of hedging risk was not patentable because it was an abstract idea just like the algorithms at issue in *Benson and Flook*. The Court stated:

The concept of hedging, described in claim 1 and reduced to a mathematical formula in claim 4 [of *Bilski*], is an unpatentable abstract idea, just like the algorithms at issue in *Benson and Flook*. Allowing petitioners to patent risk hedging would preempt use of this approach in all fields, and would effectively grant a monopoly over an abstract idea.

Petitioners' remaining claims are broad examples of how hedging can be used in commodities and energy markets. *Flook* established that limiting an abstract idea to one field of use or adding token postsolution components did not make the concept patentable. That is exactly what the remaining claims in petitioners' application do. These claims attempt to patent the use of the abstract idea of hedging risk in the energy market and then instruct the use of well-known random analysis techniques to help establish some of the inputs into the equation. Indeed, these claims add even less to the underlying abstract principle than the invention in *Flook* did, for the *Flook* invention was at least directed to the narrower domain of signaling dangers in operating a catalytic converter. *Id.*, at Syllabus, page 3).

The Court's concern with abstract ideas is the preemption of other fields and the granting of a monopoly over an abstract idea. In the *Flook*, *Benson*, and *Diehr* cases cited by the Supreme Court, as well as in the *O'Reilly v. Morse* case referenced in each of the *Flook*, *Benson*, and *Diehr* cases, ideas considered abstract were either explicitly directed to non-statutory subject matter or where the claims were so broadly drafted as to encompass other technologies or areas of technologies not contemplated and/or not supported by the written description.

For example, in *O'Reilly v. Morse* (15 How. 62), Morse was allowed a patent for a process of using electro-magnetism to produce distinguishable signs for telegraphy. *Id.*, at 111. The Court denied a claim in which Morse claimed the use of electro-magnetism for marking or printing intelligible characters, signs, or letters, at any distance. The Court in disallowing that claim said, "If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we now know some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's

specification.” *Id.*, at 113.

Applicant submits that: first, independent claims 1 and 21 of the present application are not directed toward non-statutory subject matter such as laws of nature, natural phenomena, mathematical algorithms, etc.; and second, the claims are narrowly tailored and are not so broad as to encompass other technologies or areas of technologies not contemplated and/or not supported by the written description.

Specifically, independent claim 1 is directed to a business method for raising funds for a charitable cause. The claims include the narrowly tailored limitations of obtaining sponsor(s) to pay for a plurality of flags; selecting a graphic layout for the flags to be erected in a predetermined pattern; erecting the flags to form a healing field; linking the display of the healing field to the charitable cause; and selling at least some of the flags that are displayed in the healing field. Independent claim 21 includes similar limitations. Thus, in view of the U.S. Supreme Court decisions in *Flook*, *Benson*, *Diehr*, *O'Reilly*, and *Bilski*, the claims of the present application are narrowly tailored and are not abstract.

Therefore, Applicant submits that independent claims 1 and 21 and dependent claims 2, 4-9, 11-18 and 20 claim statutory subject matter under 35 U.S.C. § 101 and respectfully requests that the rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 112

Claims 1-9 and 11-21 stand rejected under § 112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claims were rejected for containing the language "flags being arranged so as to stimulate an emotional response". This language has been removed from the claims to further clarify the claim language. The language was replaced with the limitations recited in dependent claim 3, stating that the flags in the field of flags are positioned in a predetermined pattern. Claim 3 has been canceled without prejudice. Dependent claims 4-7, which were dependent on claim 3, have been amended to change their dependencies to claim 1. Independent claim 19 has been canceled. Claims 11, 12, and 20 have been amended to put them in a better condition for appeal.

The Office Action also asserts that the language "designed to educate" is indefinite. Claims 1 and 21 have been amended to clarify that linking a display of the healing field to the charitable cause in need of funding involves carrying out a public awareness campaign to associate the charitable cause with the healing field. These limitations are clearly supported in the specification. Specifically, the specification states:

"Linking a display of the healing field to the charitable cause can involve educating the public about the charitable cause and how the healing field relates to that charitable cause. For example, a bank may sponsor a healing field representing a historical event, such as child abuse. People entering the bank may see advertisements in the bank concerning child abuse, with a plea to donate to the cause by sponsoring a flag that will appear in the healing field. Over time, tens to tens of thousands of sponsors may sign up to sponsor a flag, depending on the charitable cause, the size of the campaign, and other factors. The sponsors may then educate their friends, neighbors, and family on the charitable cause and its association to the healing field. The healing field may also be linked to the charitable cause by educating people through other forms of media such as radio, television, posters and signs in businesses, churches, clubs, public places, and any other form of communication that can educate the public. Sponsors may even go door to door, educating people and businesses about the field of flags and what it represents. Sponsorship of flags in the healing field is not limited to individuals. Churches, clubs, organizations, businesses, and corporations can sponsor single flags or groups of flags."

Thus, the limitation in claims 1 and 21 of "linking a display of the healing field to the charitable cause in need of funding by carrying out a public awareness campaign to associate the charitable cause with the healing field" is clearly taught and is sufficient to particularly point out and distinctly claim the subject matter.

In view of the amendments made to the claims and the clarification provided above, Applicant respectfully submits that claims 1, 2, 4-9, 11-18, 20 and 21 are allowable, and urges the Examiner to withdraw the rejections under 35 U.S.C. § 112.

Claim Rejections - 35 U.S.C. § 103

Claims 1-9 and 11-21 (including independent claims 1 and 21) were rejected under 35 U.S.C. § 103 as being unpatentable over Exhibit U in view of Harmon et al. (U.S. Pub. No. 2004/0181468), hereinafter "Harmon".

The Exhibit U and Harmon references, when combined, do not teach or suggest all of the elements of independent claim 1.

The Exhibit U reference discloses a planned 30 acre national park and museum dedicated to the honor of the U.S. flag. (See page 1). The reference discloses plans for a “Field of Honor” containing over one-hundred granite memorial markers, as well as a “Flags of Freedom Monument” containing state and colonial flags located around 5 pools forming the shape of a star.

However, Exhibit U does not teach or suggest identifying a charitable cause in need of funding. Nor does Exhibit U teach or suggest a sponsor that initially pays for flags to be displayed in a field, followed by selling the flags displayed in the field to raise additional funds. Indeed, there is no discussion in Exhibit U about selling flags or other objects that were previously purchased through donations from sponsors. Any income raised for charitable causes disclosed in Exhibit U is limited to donations made for permanent displays at the proposed field of honor. Thus, a display such as the national park and museum disclosed in Exhibit U would very likely not be used for a wide variety of fund raising efforts, such as breast cancer, child abuse, and so forth. Rather, the only fund raising discussed in Exhibit U is to build the exhibit itself.

In contrast to the teachings of Exhibit U, claim 1 of the present application recites, in part, the operation of identifying a charitable cause in need of funding. (See page 2, lines 32-32). The charitable cause can be a wide variety of different subjects. For example, the specification provides examples related to church congregations, communities, cities, states, or a nation. The charitable cause can relate to historical figures, the impact of diseases such as cancer or muscular dystrophy, and so forth. The method recited in claim 1 can be used to raise funds for a wide number of charitable causes and is not limited to a specific park or museum as Exhibit U is. Exhibit U does not teach or suggest the ability to identify a charitable cause.

Claim 1 further recites the operation of obtaining one or more sponsors to fund the charitable cause by paying for a plurality of flags. At least some of the plurality of flags that are displayed in the healing field are sold to raise additional funds for the charitable cause in need of funding. This provides additional fund raising ability for a charity than the traditional method disclosed in Exhibit U.

In addition, by selling the flags to additional donors when the display period of the healing field is completed, the public awareness of the charitable cause is further spread. Flags are often

used to commemorate emotional events because they promote an emotional response in people. Once the healing field has been taken down, the flags can be displayed at numerous locations by different purchasers, enabling public attention to the charitable cause to be furthered even after the healing field is taken down. Thus, the present method can be used both to increase the profits that can be donated to the charitable cause, as well as to increase the public attention to the charitable cause. (See specification, page 5, lines 4-10).

The Harmon reference discloses a method of funding a charity in which an item associated with a charity is sold at a first price to a first buyer, and then resold at an increased price to a second buyer, with portions of each sale donated to the charity. Harmon gives several examples of tickets to concerts or sporting events that may increase in price due to issues of limited supply and high demand. For example, a popular rock concert may have more demand than supply. (See Harmon, ¶ [0028]). This can create a condition in which the ticket may be purchased and resold at an increased cost. (See Harmon, ¶ [0031]). However, the method disclosed in Harmon is limited to atypical market conditions in which the demand significantly outstrips supply for a selected item. In many types of charitable causes, such as cancer, chronic illnesses, veterans associations, military tributes, and so forth, the law of supply and demand do not create a market condition in which an item can continue to be sold at an increasing cost.

In contrast to the teachings of Harmon, in the present application, as recited in claim 1, an object is not sold to a first buyer, with the option to resell to a second buyer at a higher price. Rather, claim 1 provides that one or more sponsors are used to fund the charitable cause by paying for a plurality of flags prior to their display. The sponsors do not own the flags, with the ability to resell them at a higher price to make money for themselves or others. Rather, the sponsors make the field of flags display possible by paying for the flags prior to their display. In many fundraising situations, charities cannot afford to purchase hundreds, or thousands of flags for display in a healing field. The sponsor donations make it possible to display the flags at a selected location. Neither Harmon nor the Exhibit U reference teach or suggest a sponsor donating to purchase flags prior to their display in a healing field for an identified charitable cause.

Claim 1 of the present invention further recites that a graphic layout is selected for a healing field that is comprised of a plurality of flags positioned in a predetermined pattern. Selection of a graphic layout is important because the graphic image helps to stimulate the desired

emotional response from the viewing public. For example, a large array of flags that are positioned in a graphic layout comprising columns and rows creates an atmosphere of reverence, eliciting a spirit of respect and admiration. (See specification, page 4, lines 14-19).

The graphic layout can be selected for a specific charitable cause. By specifically selecting the graphic layout for the selected charitable cause, the emotional response evoked by the layout can be increased. The stimulation of the emotional response provides a value to the flags. Those viewing the healing field can purchase a flag in the display to remind them of the charitable cause associated with the healing field. As previously discussed, this enables additional funding to be provided to the charitable cause. In addition, it enables the flags from the healing field to be displayed by numerous purchasers over a wide range of locations after the healing field has been taken down. The price at which the flags in the healing field display are sold may not necessarily be for more than the funds donated by the sponsors purchasing the flags. However, the additional money raised by selling the flags in the display is beneficial to the charitable cause. Thus, the teachings in Harmon of reselling an item for a greater price cannot be attributed to the present invention, as recited in claim 1. Moreover, the teachings of Exhibit U of a static layout of flags is not as effective as the process recited in claim 1, which enables the graphic layout to be selected for the specific charitable cause.

In addition, the teachings of Exhibit U and the Harmon reference cannot be combined. As previously discussed, Harmon discloses a 30 acre national park and museum dedicated to honor the U.S. flag. The public can support the project by purchasing bricks for \$50.00 that will be displayed in the park. (See Exhibit U, page 4). The person's name and hometown or state will be printed on their brick. Of course, once a person's personal information is printed on a brick, the ability to resell the brick to another is minimal. The value of the brick to others will fall to near zero, since others can purchase bricks with their own personal information displayed. Thus, the fund raising method disclosed in Harmon cannot be applied to the teachings of Exhibit U.

In contrast to the cited art, the present application, as recited in claim 1, provides a method for raising funds for a charitable cause. Sponsors can pay for a plurality of flags prior to their display. A graphic layout can be selected for the healing field that is comprised of a plurality of flags in a predetermined pattern. A selected location can then be transformed to display the plurality of flags. A display of the healing field can be linked to the charitable cause by carrying

out a public awareness campaign to associate the charitable cause with the healing field. (See specification, page 3, lines 24-34).

Exhibit U does not teach or suggest having sponsors pay for a plurality of flags prior to their display, as recited in claim 1. Nor does Exhibit U teach or suggest linking a display of the healing field to the charitable cause in need of funding by carrying out a public awareness campaign, as recited in claim 1. Merely asking for donations for bricks to contribute to building the 30 acre national park and museum is not the same as linking a display of a specifically created healing field for a selected charitable cause. Moreover, the Harmon reference does not overcome these limitations.

Independent claim 21 has been similarly amended. Therefore, Applicant respectfully submits that independent claims 1 and 21 are allowable, and urges the Examiner to withdraw the rejection.

Rejection of the dependent claims 2, 4-9, 11-18 and 20 should be reconsidered and withdrawn for at least the reasons given above with respect to the independent claims. The dependent claims, being narrower in scope, are allowable for at least the reasons for which the independent claims are allowable.

CONCLUSION

In light of the above, Applicant respectfully submits that pending claims 1, 2, 4-9, 11-18, 20 and 21 are now in condition for allowance. Therefore, Applicant requests that the rejections and objections be withdrawn, and that the claims be allowed and passed to issue. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to call Chris Johnson at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

A Request for Continued Examination (RCE) under 37 C.F.R. 1.114 is filed herewith. Fees in the amount of \$405.00 will be submitted electronically pursuant to 37 C.F.R. § 1.17(e). Pursuant to 37 C.F.R. § 1.136(a), it is respectfully requested that the shortened statutory period be extended one month. Fees in the amount of \$65.00 will be submitted electronically pursuant to 37 C.F.R. § 1.17(a). No claims were added. Therefore, no additional fee is due.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 20-0100.

DATED this 17th day of August, 2010.

Respectfully submitted,

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